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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,008	03/25/2004	Bryan L. Dalton	LM(F)6495 NP	7833
26294 7590 01/22/2007 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114			EXAMINER NGUYEN, PHILLIP H	
			ART UNIT 2191	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/22/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/809,008

Applicant(s)

DALTON ET AL.

Examiner

Phillip H. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 20040325
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to the original filing of March 25, 2004. Claims 1-20 are pending and have been considered below.

Claim Objections

2. Claims 1-3, 6-7, 9, 11-12, and 15-20 are objected to because of the following informalities:

These claims recite the word "for" or "capability" in the preamble and body of the claim, which indicates intended use and as such does not carry patentable weight. The limitation following the phrase "for" describes only intended use but not necessarily required functionality of the claim. The limitations following the phrase "for" do not carry patentable weight, which cause the claims to appear as a series of non-descriptive material/data without any functional relation with each other. Applicant is required to amend the claims so that the claim limitations are recited in a definite form. For example, claim 1 recites, "for enabling" should be change to "to enable".

Appropriate correction is required.

3. Applicant is advised to add a semicolon at the end of every limitation for interpretation purposes.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter:

Claim 15 recites "a computer program product", which is directed to software, per se, lacking storage on a medium, which enables any underlying functionality to occur. Additional item to consider is the word "for" recited in the preamble and the body of the claims. It indicates intended use and as such does not carry patentable weight. The limitations following the phrase "for" describe only intended use but not necessarily required functionality of the claim, which cause the claim to appear as a series of non-descriptive material/data without any functional relation with each other. Claims should be amended to recite for example "to enable" or "that enable". Therefore, claim 15 is non-statutory.

Claims 16-20 are in the same format as claim 15 and directly depend on claim 15, and therefore, have been addressed in connection with the rejection set forth to claim 15.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-8, 11, 13-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Delo et al. (United States Patent No.: US 6,370,686).

As per claim 1:

Delo discloses a system for enabling a mobile data acquisition device, said system comprising:

- a software application ("**A product**" Col 5, line 63) for use with the mobile data acquisition device, the software application being located on a remote computer ("**program modules depicted relative to the personal computer 20, or portions thereof, may be stored in the remote memory storage device**" Col 5, line 47-49);
- the remote computer transferring the software application from the remote computer to the mobile data acquisition device ("**initiating the installation may constitute the act of executing a remote startup script over a network connection**" Col 6, line 46-49); and
- the remote computer installing and activating the software application ("**The installer application 201 begins the installation by reading the package file 213 into memory... the installer application 201 reads the package file 213 and uses the information stored within to determine the installation operations that must be performed for the product**" Col 6, line 52-62) for use by the mobile data acquisition device, the software

application being determined by a user (**"a user initiates the installation of the product"** Col 6, line 44-45) and replacing a factory default software application (**"A product represents a single, entire application program such as the Microsoft Office application program marketed by Microsoft Corporation of Redmond, Wash"** Col 5, line 63-65).

As per claim 2:

Delo discloses the system as in claim 1 above; and further discloses:

- wherein the remote computer enables a first set of applications (**when the product transferred from remote computer to target computer and installed on the target computer, the software product is enabled by the remote computer in order to run on the target**) for the mobile data acquisition device, the first set of applications being define by a first User Role (**"a dialog box which presents to user with the option of selecting which features of the product to install"** Col 6, line 63-65, this means, **user select which feature is applicable for user role**).

As per claim 3:

Delo discloses the system as in claim 2 above; and further discloses:

- wherein the remote computer disables the first set of applications (**when installing a new version product, the old product is disable from the target computer**) and enables a second set of applications (**and the new**

software product is enabled in order to run on the target computer) for mobile data acquisition device, the second set of applications being defined by a second User Role (“a dialog box which presents to user with the option of selecting which features of the product to install” Col 6, line 63-65, this means, user select which feature is applicable for the new software product’s user role).

As per claim 4:

Delo discloses the system as in claim 1 above; and further discloses:

- wherein the mobile data acquisition device includes a User Role selection module, an application list module, and an application selection module (“a dialog box which presents the user with the option of selecting which features of the product to install. The user may be presented with the option of selecting a “Word” feature, an “Excel” feature, and a “Proofing Tools” feature. The user may then select which features to install... a feature is a group of components, and the components identify the actual resources to be installed to the computer” Col 6-7 line 64-67; 1-4).

As per claim 5:

Delo discloses the system as in claim 4 above; and further discloses:

- wherein the User Role selection module displays a list of User Roles for the user (**"a dialog box which presents the user with options of selecting which features of the product to install"** Col 6, line 64-65).

As per claim 6:

Delo discloses the system as in claim 4 above; and further discloses:

- wherein the application list module maintains a list of available software applications (**"the user may be selected with the option of selecting a "Word" feature, an "Excel" feature,..."** Col 6, line 66-67) for the mobile data acquisition device.

As per claim 7:

Delo discloses the system as in claim 4 above; and further discloses:

- wherein the application selection module maintains a list of enabled software applications (**"the user may be selected with the option of selecting a "Word" feature, an "Excel" feature,..."** Col 6, line 66-67, **the "Word", "Excel" and "Proofing Tools" are enabled software applications in order to install and run on the target computer)** for the mobile data acquisition devices.

As per claim 8:

Delo discloses the system as in claim 1 above, but does not explicitly disclose:

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- wherein the mobile data acquisition device disables a software application no longer needed by the mobile data acquisition device. It is inherent in Delo's installation process because in order for the new product to run properly on the target computer, the old version must be disabled.

As per claim 11:

Delo discloses a system for enabling a software application, said system comprising:

- a data acquisition device ("**person computer 20**" Col 5, line 27) for use with the software application;
- a remote computer ("**a remote computer 49**" Col 5, line 29) for transmitting the software application from said remote computer to said data acquisition device ("**initiating the installation may constitute the act of executing a remote startup script over a network connection**" Col 6, line 46-49); and
- said remote computer installing and activating the software application ("**Once the software product 136, the installation database 139... are introduced to the target computer system 120, the processing unit 121 executes the instructions of the installation program module 137 to install an install-set of the software product 136**" Col 6, line 22-26) for use by said data acquisition device, said data acquisition device having the capability of disabling a software application of said data acquisition device

(when installing a new version of product, the old version is disabled or removed).

As per claim 13:

Delo discloses the system as in claim 11 above; and further discloses:

- wherein said remote computer removes invalid applications from an application activation file **(the remote computer indirectly remove old application, like "Word", "Excel" and so forth from the file of the target computer during the installation of new product).**

As per claim 14:

Delo discloses the system as in claim 11 above; and further discloses:

- wherein said data acquisition device acknowledges receipt of the software application from the remote computer **("Once the installation is initiated, the installer application 201 assumes the control of processing" Col 6, line 50-51, the computer 20 must acknowledge receipt of the software application from the remote computer in order to perform the installation process).**

As per claim 15:

Delo discloses a computer program product ("**A "product" represents a single, entire application program**" Col 5, line 63) for enabling a software application, said computer program product comprising:

- a first instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for initiating communication between a mobile device and a remote computer (**Note: no patentable weight is giving for intended use**);
- a second instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for requesting the state of the mobile device by the remote computer;
- a third instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for responding to the remote computer by the mobile device with a factory default state message;
- a fourth instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for initiating transfer of a software application from the remote computer to the mobile device; and

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- a fifth instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for acknowledging receipt of the software application from the remote computer by the mobile device thereby enabling the software application at the mobile device.

As per claim 16:

Delo discloses the computer program product as in claim 15 above; and further discloses:

- including a sixth instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for changing a status of the mobile device from a "factory default" state to an "operational" state.

As per claim 17:

Delo discloses the computer program product as in claim 15 above; and further discloses:

- including a sixth instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for rebooting the mobile device.

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As per claim 18:

Delo discloses the computer program product as in claim 15 above; and further discloses:

- including a sixth instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for running the software application on the mobile device.

As per claim 19:

Delo discloses the computer program product as in claim 15 above; and further discloses:

- including a sixth instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction, fifth instruction, sixth instruction, and so forth**) for sending an application activation file from the mobile device to the remote computer.

As per claim 20:

Delo discloses the computer program product as in claim 15 above; and further discloses:

- including a sixth instruction (**A product must include many instructions; a first instruction, second instruction, third instruction, forth instruction,**

fifth instruction, sixth instruction, and so forth) for ceasing communication between the mobile device and the remote computer.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 9-10 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delo et al. (United States Patent No.: US 6,370,686 B1), in view of Delo (United States Patent No.: US 6,804,663 B1).

As per claim 9:

Delo (US 6,370,686 B1) discloses the system as in claim 1 above, but does not explicitly disclose:

- wherein the remote computer maintains an application installation log for determining software applications enabled at a given time.

However, Delo (US 6,804,663 B1) discloses an analogous system includes:

- wherein the remote computer maintains an application installation log ("**The installation program module 137 may gather information regarding the current state of the computer system 120**" Col 6, line 35-36) for determining software applications enabled at a given time.

Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Delo (US 6,370,686 B1)'s approach to gather information regarding the current state of the target computer. One of ordinary skill in the art would have been motivated to modify in order to **determine which components of the software product are to be installed** (see Delo US 6,804,663 B1 Col 6, line 39-40).

As per claim 10:

Delo (US 6,370,686 B1) discloses the system as in claim 1 above, but does not explicitly disclose:

- wherein the remote computer requests an application activation file from the mobile data acquisition device.

However, Delo (US 6,804,663 B1) discloses an analogous system includes:

- wherein the remote computer requests an application activation file from the mobile data acquisition device ("**The installation program module 137 may gather information regarding the current state of the computer system 120... to determine which components of the software product 136 are to be installed in the install-set**" Col 6, line 35-41, this means, the remote computer gather information about which components of the software product are activated on the target computer).

Therefore, it would have obvious to one having an ordinary skill in the art at the time the invention was made to modify Delo (US 6,370,686 B1)'s approach to gather

information of the installation process. One of ordinary skill in the art would have been motivated to modify in order to know which components of the software product are activated on the target computer.

As per claim 12:

Delo (US 6,370,686 B1) discloses the system as in claim 11 above; and further discloses:

- wherein said remote computer initiates transfer of the software application subsequent to said data acquisition device (**"the installation of the product may constitute the act of executing a remote startup script over a network connection"** Col 6, line 46-48).

Delo (US 6,370,686 B1) does not explicitly disclose:

- sending an application activation file to said remote computer.

However, Delo (US 6,804,663 B1) discloses an analogous system including:

- sending an application activation file to said remote computer (**"The installation program module 137 may gather information regarding the current state of the computer system 120... to determine which components of the software product 136 are to be installed in the install-set"** Col 6, line 35-41, **this means, the remote computer gather information about which components of the software product are activated on the target computer**).

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Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Delo (US 6,370,686 B1)'s approach to have installation information gathered. One of ordinary skill in the art would have been motivated to have installation information gathered for the remote computer in order to know which components of the software product are activated on the target computer.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip H. Nguyen whose telephone number is (571) 270-1070. The examiner can normally be reached on Monday - Thursday 10:00 AM - 3:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Y. Zhen can be reached on (571) 272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PN
01/10/2007



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